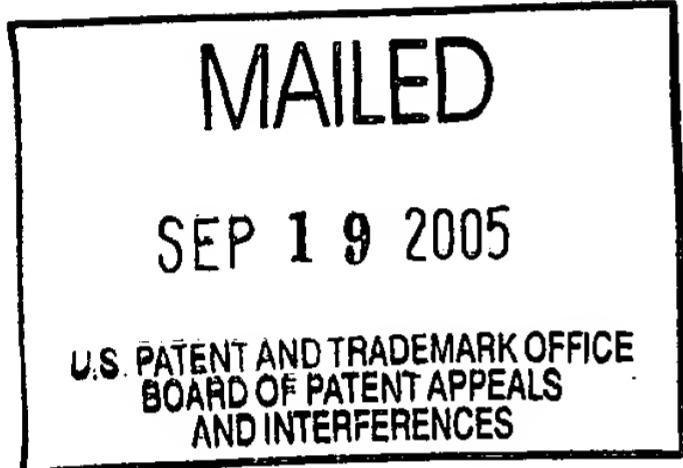


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NEELAKANTAN SUNDARESAN



Appeal No. 2005-1719
Application No. 09/191,281

ON BRIEF

Before HAIRSTON, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-69. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

I. BACKGROUND

The invention at issue on appeal generates a visual editor. With the realization that the World Wide Web ("Web") is not limited to browsing, explains the appellant, the eXtensible Markup Language ("XML") has emerged as an enabling technology to carry the Web to the next generation of electronic commerce, Web-based workflow, and integration of databases with Web applications. (Spec. at 2.)

XML describes a class of data objects called "XML documents" and the behavior of computer programs that process these. (*Id.*) An "XML schema" specifies constraints on the structures and types of elements in an XML document. Document Type Definition ("DTD") is the basic schema for XML; other XML schema definitions include Document Content Definition ("DCD") and Xschema. (Spec. at 3.)

Although the construction of editors is well known in the art, the appellant observes a need for editors that facilitate creating or editing XML documents. (*Id.* at 5.) Accordingly, as shown in Figures 1 and 2 of his specification, the appellant's invention automatically generates a visual editor 118 from an XML schema 116 and then uses the visual editor to edit data contained in corresponding XML documents. (*Id.* at 26-27.) Entities within the XML schema are mapped to components of the visual editor (e.g., forms, widgets) that are generated as class specifications 200, 202, 204. The class specifications can be customized through the use of a customization specification file 206. The class specifications are then instantiated as objects in a Java Virtual Machine 110 to perform the functions of the visual editor. (*Id.* at 27.)

According to the appellant, a user does not need to know the specifics of the structure of an XML document or an XML schema to operate the visual editor. Instead,

he simply uses the visual editor to complete forms, interact with widgets and other components of the visual editor 118. In turn, the visual editor creates or edits the XML document. (*Id.* at 11.)

A further understanding of the invention can be achieved by reading the following claim.

1. A computer-implement method for generating a document editor, comprising:

(a) generating one or more class specifications in the computer from a schema for the document, wherein the class specifications identify user interface components of the editor corresponding to entities defined in the schema; and

(b) instantiating one or more objects in the computer from the class specifications to invoke the editor.

Claims 1, 4-7, 24, 27-30, 47, and 50-53 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,272,673 ("Dale") and U.S. Patent No. 5,920,879 ("Kyojima"). Claims 2, 17, 18, 25, 40, 41, 48, 63, and 64 stand rejected under § 103(a) as obvious over Dale, Kyojima, and *Extensible Markup Language (XML): Part I. Syntax* ("Bray"). Claims 3, 26, and 49 stand rejected under § 103(a) as obvious Dale, Kyojima, Bray, *XML DTDs and Valid XML Documents* ("Kirsanov"), and *Document Content Description for XML* ("Bray 2"). Claims 8-10, 21, 31-33, 44, 45, 54-56, 67, and 68 stand

rejected under § 103(a) as obvious over Dale, Kyojima, and *SoftQuad HoTMetal Pro 3.0 User's Manual* ("HotMetal Pro"). Claims 11-15, 34-38, and 57-61 stand rejected under § 103(a) as obvious over Dale, Kyojima, HotMetal Pro, and *W3C Extensible Markup Language (XML) 1.0* ("W3C"). Claims 16, 23, 34-37, 39, 46, 57-60, 62, and 69 stand rejected under § 103(a) as obvious over Dale, Kyojima, and W3C. Claims 19, 20, 42, 43, 65, and 66 stand rejected under § 103(a) as obvious over Dale, Kyojima, Bray, and HotMetal Pro.

II. OPINION

Rather than reiterate the positions of the examiner or the appellant *in toto*, we focus on a representative point of contention therebetween. The examiner asserts, "Dale teaches creating one director component in which the components are Java components embedded in the document. See column 10, lines 50-59." (Examiner's Answer at 11.) He then invites us to "[c]ompare to 'generating class specifications in the computer system'." (*Id.*) The appellant argues that "at the location indicated by the Examiner, the editor in Dale merely constructs web-based applications, wherein the web pages include tags to applets that may be downloaded when the pages are accessed, and the director component is merely an applet [which] interconnects other

components (applets)." (Reply Br. at 3-4.) He adds, "There is no correspondence between this description in Dale and Appellant's claim limitation." (*Id.* at 4.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

A.. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claim 1 recites in pertinent part the following limitations:
"[a] computer-implement method for generating a document editor, comprising . . . generating one or more class specifications in the computer from a schema for the document, wherein the class specifications identify user interface components of the

editor corresponding to entities defined in the schema. . . ." Claims 24 and 47 recite similar limitations.

B. OBVIOUSNESS DETERMINATION

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Dale's "present invention includes a mechanism for enabling a user to create a software application." Col. 2, ll. 24-25. The passage of the reference cited by the examiner follows.

Note that in one embodiment, an application of the present invention will create one director component and one director sub-component for each

distinct scope level used by the application. For example, if certain components default to the "request" scope while others are specified as "application" scope for a given tier, then at least two director components and at least two director sub-components would be created on that tier, i.e., one for "request" scope and one for "application" scope.

Col. 10, ll. 50-59. After comparing this passage to the aforementioned limitations, we fail to see a correspondence. In particular, we fail to see a correspondence between the contents of the passage and the claimed "document editor," "class specifications," document "schema," "user interface components," and "entities defined in the schema."

We also do not understand how the examiner's proposed addition of Kyojima would have cured the aforementioned deficiency of Dale. Nor does the examiner allege, let alone show, that the addition of Bray, Kirsanov, and Bray 2, HotMetal Pro, or W3C cures the deficiency of Dale. Absent a teaching or suggestion of a computer-implement method for generating a document editor, comprising generating one or more class specifications in the computer from a schema for the document, wherein the class specifications identify user interface components of the editor corresponding to entities defined in the schema, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejections of claim 1; of claims 2-23, which depend from claim 1; of claim 24; of claims 25-46, which depend from claim 24; of claim 47; and of claims 48-69, which depend from claim 47.

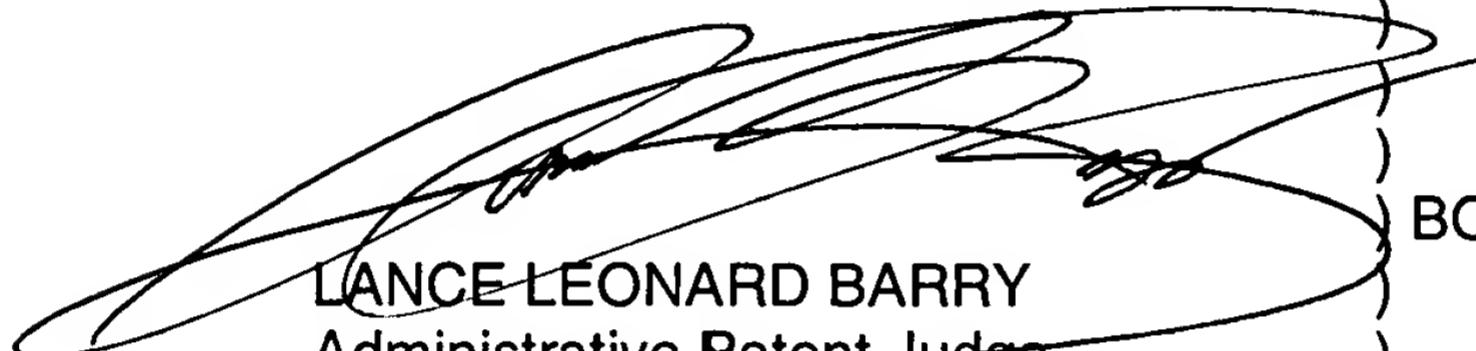
III. CONCLUSION

In summary, the rejections of claims 1-69 under § 103(a) are reversed.

REVERSED



KENNETH W. HAIRSTON
Administrative Patent Judge



LANCE LEONARD BARRY
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES



STUART S. LEVY
Administrative Patent Judge

GATES & COOPER LLP
HOWARD HUGHES CENTER
6701 CENTER DRIVE WEST, SUITE 1050
LOS ANGELES, CA 90045